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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,682

05/29/2007

Patrick McCorry

1-24998

3401

46582

7590

03/02/2011

MACMILLAN, SOBANSKI & TODD, LLC  
ONE MARITIME PLAZA - FIFTH FLOOR  
720 WATER STREET  
TOLEDO, OH 43604

EXAMINER

TAOUSAKIS, ALEXANDER P

ART UNIT

PAPER NUMBER

3726

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,682	<b>Applicant(s)</b> MCCORRY ET AL.	
	<b>Examiner</b> ALEXANDER P. TAOUSAKIS	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

**Claim 38 is objected to** because of the following informalities:

The claim includes "a third window piercing operation" in lines 2-3, yet parent claim 35 fails to teach first and second window portions. It appears that this phrase should be changed to ---third window forming operation--- to be consistent with the language of parent claim 35.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

**The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 19-42 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 19, 27 and 35 include the limitation of "*the second window portion being formed in the wheel disc in a separate portion of the wheel disc not including the first window portion*" which was not described in the specification to enable one of ordinary skill in the art to perform the newly claimed method.

This subject matter is considered *new matter*. The specification has not provided support for forming two *separate* window portions, but instead teaches that the window portions cooperate to form a single window (*see the Publication [0003] lines 24-25 and see Figure 9, where the first window portion is indicated at 170 and the second window portion is indicated at 172*). Since there is no description of two piecing operations forming two separate and distinct window portions, the above claim limitation is considered new matter.

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 19-42 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 19, 27 and 35 include the limitation of “the second window portion being formed in the wheel disc in a separate portion of the wheel disc not including the first window portion” which was not described in the specification to enable one of ordinary skill in the art to perform the newly claimed method. This phrase may be construed to teach forming a second window portion *completely separate* from that of the first window portion, i.e. not adjacent or cooperating. All of these claims furthermore include the limitation (or an equivalent) “the first window portion and the second window portion cooperating to define a pierced window,” i.e. the first and second window portions together form a single window portion. The first phrase includes that the window portions are separate, yet the subsequent phrase includes that

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the window portions are in fact *not* separate, but instead *cooperate* to form a single window. The claim is unclear and ambiguous because it teaches two completely diverging and distinct limitations which cannot be read together in a single claim.

**Claims 26, 34 and 42 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 34 and 42 recite the limitation "the two connecting zones" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 35 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Coleman (2003/0080606).**

#### **Claim 35:**

Ono teaches punching/piercing holes/window portions 4a and 4b into a wheel portion located between spokes (7) (*see Figures 4a-4b and column 7 lines 39-49*), and subsequent forging operations to shape the window portions to form a second window portion that cooperates with the first window portion (*see column 7 lines 51-60 and*

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*Figures 4b-4d*), and where the window portions extend to the outermost periphery of the wheel and have a predetermined shape along with the wheel (*see Figure 4a*).

**Claim 42:**

Ono teaches two clearance zones (9a, 9b) in the windows (*see Figure 4d*), the zones establish a departure from the shape of the window portion (*see Figure 4a-4d*, where it shows that the portions 9a and 9b have a curved portion which differs from the profile of the window portion 7 initially formed, which are described as depression (*see column 7 lines 45-50*).

***Allowable Subject Matter***

Claims 19-34, 36-41 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art, including Coleman (2003/0080606) and Ono (7,523,635), fail to teach the claimed method, comprising: providing a wheel rim and a disc attached to the rim, the wheel having a plurality of outwardly extending spokes and an outer rim, performing a first window piercing operation which produces a window portion between an adjacent pair of spokes and a second window piercing operation to form a second portion which cooperates with the first window portion to form a single window portion. Coleman teaches forming a first window portion (184) by piercing (*see Figures 9-10 and [0044]*) and thereafter coining the window portion to remove sharp edges and to form the final shape (*see Figures 10-10a and [0045]*). Coleman fails to teach a second

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*piecing/punching* operation to form the window portion. Ono teaches punching holes/window portions 4a and 4b into a wheel portion located between spokes (7) (*see Figures 4a-4b and column 7 lines 39-49*), and subsequent forging operations to shape the window portions (*see column 7 lines 51-60 and Figures 4b-4d*), but also fails to teach a second piercing operation to form a second window portion that cooperates with the first window portion.

### ***Response to Arguments***

Applicant's arguments with respect to claims 19-43 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER P. TAOUSAKIS whose telephone number is (571)272-3497. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID P. BRYANT/  
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